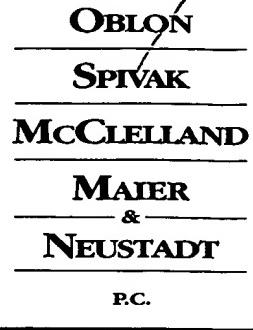




Docket No.: 213287US6X



COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

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RE: Application Serial No.: 09/940,462

Applicants: Jean-Marie STAWIKOWSKI, et al.

Filing Date: August 29, 2001

For: COMMUNICATION SYSTEM OF AN
AUTOMATION EQUIPMENT BASED ON THE
SOAP PROTOCOL

Group Art Unit: 2152

Examiner: Zhong, C.

SIR:

Attached hereto for filing are the following papers:

APPEAL BRIEF WITH APPENDICES

Our credit card payment form in the amount of **\$500.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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DOCKET NO: 213287US6X

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

JEAN-MARIE STAWIKOWSKI, ET AL.

: EXAMINER: ZHONG, C.

SERIAL NO: 09/940,462

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APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is an appeal from the decision of the Examiner dated October 14, 2005, which finally rejected Claims 1-20 in the above-identified patent application. A Notice of Appeal was timely filed with a one month extension of time on February 14, 2006.

I. REAL PARTY-IN-INTEREST

The real part-in-interest is Schneider Automation.

II. RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' legal representative, and the assignees are aware of no appeals which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1-20 have been finally rejected and form the basis for this appeal. Appendix VIII includes a clean copy of appealed Claims 1-20.

IV. STATUS OF AMENDMENTS

No amendments after final rejection have been filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1 is directed to a communication system including at least one processing unit capable of running a program to provide automation functions, and one or more remote devices running a computer program or group of computer programs. The communications system is based on the Simple Object Access Protocol (SOAP) for the purpose of providing the remote device with supervision, display, control, configuration or programming functions of the automation equipment. The communications system comprises, in the automation equipment, at least one WEB service or one WEB client which is capable of (1) interacting with the program of the automation equipment, (2) decoding messages received from the IP network encoded according to the SOAP protocol, and (3) encoding according to the SOAP protocol messages to be sent on the IP network. An exemplary embodiment is described in the specification from page 6, line 25 to page 7, line 21 with reference to Figure 1. In this exemplary embodiment, automation equipment 10 includes at least one processing unit capable of running a program 20 to provide automation functions. A remote device 30 runs a computer program 31. Automation equipment 10 includes at least one WEB service 21 or one WEB client 22 which is capable of (1) interacting with the program 20 of the automation equipment 10, (2) decoding messages

received from IP network 50 encoded according to the SOAP protocol, and (3) encoding according to the SOAP protocol messages to be sent on the IP network 50.

Independent Claim 18 is directed to a communication process including: running a computer application in a remote device, sending from an application a read request on an IP network in order to receive in a response a service description document, developing, manually or automatically, by means of the service description document, all or part of a WEB client application and/or a WEB server application in the remote device so as to be able to communicate with a WEB service and/or a WEB client of an automation equipment, and communicating between a WEB client application and/or a WEB server application of the remote device and a WEB service and/or a WEB client of the automation equipment on the IP network by means of requests and responses complying with the SOAP protocol. An exemplary embodiment is described in the specification from page 14, line 30 to page 16, line 4 with reference to Figure 6. In this exemplary embodiment, remote device 30 runs a computer program 33 that sends a read request over IP network 50 in order to receive service description document 61. Remote device 30 includes a computer program 33 which develops WEB client application 31 and/or WEB server application 32 from the service description document 61. WEB client application 31 and/or WEB server application 32 communicates with WEB service 21 and/or WEB client 22 of automation equipment 10 on IP network 50 by means of requests and responses complying with the SOAP protocol.

Independent Claim 19 is directed to a communication process including: running a computer application in a remote device, sending from the application a read request on an IP network in order to receive, in a response, a service description document, and communicating between a WEB client application and/or a WEB server application included in the computer application of the remote device and a WEB service and/or a WEB client of automation equipment on the IP network, by means of requests and responses complying

with the SOAP protocol. An exemplary embodiment is described in the specification from page 14, line 30 to page 16, line 4 with reference to Figure 6. In this exemplary embodiment, remote device 30 runs a computer program 33 that sends a read request over IP network 50 in order to receive service description document 61. Remote device 30 includes WEB client application 31 and/or WEB server application 32 which communicate with WEB service 21 and/or WEB client 22 of automation equipment 10 on IP network 50 by means of requests and responses complying with the SOAP protocol.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are:

- (a) whether Claims 1-11 and 13-20 are anticipated under 35 U.S.C. §102(b) by Linderman (U.S. Patent Publication No. 2002/0032790, hereinafter “Linderman”); and
- (b) whether Claim 12 is unpatentable under 35 U.S.C. §103(a) over Linderman in view of ‘Frequently Asked Questions about XML’, (Microsoft, June 2000).

VII. ARGUMENTS

A. Introduction

Claim 1 recites a communication system comprising, *inter alia*:

- at least one processing unit capable of running a program to provide automation functions; and
- one or more remote devices running a computer program or group of computer programs,

wherein the communications system is based on the Simple Object Access Protocol (SOAP) for the purpose of providing the remote device with supervision, display, control, configuration or programming functions of the automation equipment, and the communications system comprises, in the automation equipment, at least one WEB service or one WEB client which are capable of interacting with the program of the automation equipment, of decoding messages received from the IP network encoded according to the SOAP protocol and of

encoding according to the SOAP protocol messages to be sent on the IP network.

Claim 18 recites a communication process including:

running a computer application in the remote device or in another remote device;

sending from the application a read request on the IP network in order to receive, in a response, a service description document,

developing, manually or automatically, by means of the service description document, all or part of a WEB client application and/or a WEB server application in the remote device so as to be able to communicate with a WEB service and/or a WEB client of the automation equipment respectively,

communicating between a WEB client application and/or a WEB server application of the remote device and a WEB service and/or a WEB client of the automation equipment on the IP network, by means of requests and responses complying with the SOAP protocol.

Claim 19 recites a communication process including:

running a computer application in the remote device;
sending from the application a read request on the IP network in order to receive, in a response, a service description document,

communicating between a WEB client application and/or a WEB server application included in the computer application of the remote device and a WEB service and/or a WEB client of the automation equipment on the IP network, by means of requests and responses complying with the SOAP protocol.

B. Claims 1-11 and 13-20 are not anticipated by Linderman

The present application claims priority from French Patent Application No. 00/11320, filed August 31, 2000. In accordance with 37 C.F.R. §1.55(a)(4), an English translation of the certified copy of this application, along with a statement that the translation of the certified copy is accurate, was submitted with the amendment filed September 9, 2005. Applicant respectfully submits that these documents perfected the claim to priority to French Patent Application No. 00/11320 under 35 U.S.C. §119. The filing date of French Patent Application No. 00/11320, August 31, 2000, antedates the filing date of July 9, 2001 of

Linderman. Therefore, applicant respectfully submits that Linderman does not qualify as prior art with respect to the present application under 35 U.S.C. §102. Only U.S. Provisional Application No. 60/208,045, filed May 31, 2000, predates the present application. Accordingly, application of the Linderman reference in this anticipation rejection is improper, and only the disclosure of U.S. Provisional Application No. 60/208,045 (P '045) is treated herein.

The outstanding Office Action conceded at page 6, lines 19-20 that P '045 does not teach the T-box 32 of Linderman. The outstanding Office Action then alleges that “the provisional application ‘045 teaches the concept of the T-box and its equivalent functionalities.”¹ However, it is respectfully submitted that well settled case law holds that a document describing “a concept” cannot anticipate a claim unless it provides as much detail as is recited in the claim. “The identical invention must be shown *in as complete detail* as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (Emphasis added). See also MPEP §2131.

In the present case, the description of “the concept of the ‘T-box’” does not provide the level of detail recited in Claim 1. P '045 does not illustrate or describe T-box 32 as shown in Figure 1 of Linderman. P '045 does not include any figures, and further only includes a general discussion of a product called “DaberNet.” For example, there is no discussion in P '045 of any automation equipment including “at least one WEB service or one WEB client which are capable of interacting with the program of the automation equipment, of decoding messages received from the IP network encoded according to the SOAP protocol and of encoding according to the SOAP protocol messages to be sent on the IP network.” The automation equipment in P '045 is presumably the remote network printers and fax machines and “smart devices” described at page 1, lines 23-26 of P '045. However, there is no

¹See the outstanding Office Action at page 7, lines 8-9.

discussion in P '045 that even “the concept of ‘the T-box’” is included in any of these devices.

Further, it is respectfully submitted that P '045 does not include an enabling disclosure of any apparatus. In accordance with well settled case law, the disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; *mere naming or description of the subject matter is insufficient*, if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003). (Emphasis added.) See also MPEP §2121.01. In the present case, P '045 includes no figures and at best vaguely describes the prospective product “DaberNet.” Thus, it is respectfully submitted that one of ordinary skill in the art would not be able to produce the apparatus allegedly disclosed by this brief document without undue experimentation. Consequently, as P '045 is not an enabling disclosure, Claim 1 (and Claims 2-11 and 13-17 dependent therefrom) is not anticipated by P '045 and is patentable thereover.

In response, the Advisory Action dated February 2, 2006 cites the present specification for enabling details of the invention recited in Claim 1.² “*In light of Applicant’s specification*, Linderman teaches the concept of a ‘web service’ because DaberNet software has a client side and a server side module.”³ Again, in accordance with the above cited case law, description of “a concept” does not teach any element of the present invention. Further, the need to cite to the present specification to support the rejection, rather than the reference itself, shows the present rejection is a hindsight rejection based on the present specification rather than P '045, and further that P '045 does not provide an enabling disclosure of the invention recited in Claim 1.

The Advisory Action further states “In response to Applicant’s arguments, client

²See Advisory Action dated February 2, 2006, page 2, lines 2-3 (Emphasis added).

³Advisory Action dated February 2, 2006, page 2, lines 3-4.

server side remote procedure calls and SNMP protocols are well known to the person of ordinary skill in the art at the time the invention was made.”⁴ No evidence whatsoever is provided to support this naked assertion. Again, the present rejection’s reliance on unspecified external evidence clearly shows that P '045 does not teach each and every element of Claim 1 and does not enable the invention recited in Claim 1.

Finally, the Advisory Action states, “Additionally, RPC calls from client to server, as well as server carrying out configuration commands to other devices are explicitly taught in the Linderman reference.”⁵ As noted above, Linderman is not prior art with respect to the present application. Accordingly, what Linderman teaches is irrelevant to (a) showing that a prior art reference teaches or suggests any of the elements of Claim 1, or (b) showing that P '045 contains an enabling disclosure of Claim 1 of the present application, as the material added to Linderman may have been developed after the filing date of the present application. Again, the reliance on a reference that is not prior art (Linderman) to show that P '045 teaches all of the elements of Claim 1 and contains an enabling disclosure of Claim 1 shows that P '045 itself does not accomplish either of these points.

Consequently, as P '045 is not an enabling disclosure and P '045 does not teach each and every element of Claim 1, Claim 1 (and Claims 2-11 and 13-17 dependent therefrom) is not anticipated by P '045 and is patentable thereover.

Independent Claims 18 and 19 recite similar elements to Claim 1, albeit in process form. Accordingly, Claims 18 and 19 (and Claim 20 dependent therefrom) is believed to be patentable over P '045 for at least the reasons described above with respect to Claim 1.

Further, P '045 does not provide any description of “a service description document” as recited in Claims 15, 18, and 19, and the outstanding Office Action only cites paragraph 36

⁴Advisory Action dated February 2, 2006, page 2, lines 9-10.

⁵Advisory Action dated February 2, 2006, page 2, lines 10-11.

of Linderman (which is not prior art) as describing this element.⁶ Accordingly, it is respectfully submitted that P '045 does not teach “wherein a generator is capable, following a request emanating from a remote device, of constructing a service description document dynamically, describing the capacities of one or more WEB services implanted in an automation equipment,” as recited in Claim 15, “sending from the application a read request on the IP network in order to receive, in a response, a service description document” or “developing, manually or automatically, by means of the service description document, all or part of a WEB client application and/or a WEB server application in the remote device” as recited in Claim 18, or “sending from the application a read request on the IP network in order to receive, in a response, a service description document” as recited in Claim 19. Consequently, Claims 15, 18, and 19 (and Claims 16, 17, and 20 dependent therefrom) further define over P '045.

C. Claim 12 is patentable over Linderman in view of ‘Frequently Asked Questions about XML’

It is noted that Claim 12 is dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above with respect to Claim 1. Further, it is respectfully submitted that ‘Frequently Asked Questions about XML’ does not cure any of the above-noted deficiencies of P '045. Accordingly, it is respectfully submitted that Claim 12 is patentable over P '045 in view of ‘Frequently Asked Questions about XML.’

⁶See the outstanding Office Action at page 4, line 18 to page 5, line 2, and page 5, lines 11-14.

Conclusion

It is respectfully requested that the outstanding rejections be REVERSED.

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. A communication system on an IP network between an automation equipment comprising:

at least one processing unit capable of running a program to provide automation functions; and

one or more remote devices running a computer program or group of computer programs,

wherein the communications system is based on the Simple Object Access Protocol (SOAP) for the purpose of providing the remote device with supervision, display, control, configuration or programming functions of the automation equipment, and the communications system comprises, in the automation equipment, at least one WEB service or one WEB client which are capable of interacting with the program of the automation equipment, of decoding messages received from the IP network encoded according to the SOAP protocol and of encoding according to the SOAP protocol messages to be sent on the IP network.

2. A communication system according to claim 1, wherein the automation equipment includes at least one WEB service able to receive from the IP network requests, coming from at least one WEB client application contained in a remote device and of sending on the IP network responses to the WEB client application of the remote device.

3. A communication system according to claim 1, wherein the automation equipment includes at least one WEB client able to send on the IP network requests to at least one WEB server application contained in a remote device and of receiving

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from the IP network responses, coming from the WEB server application of the remote device.

4. A communication system according to claim 2, further wherein a service description document describes the capacities of one or more WEB services implanted in the automation equipment, this service description document being accessible by the remote device either from its local resources, or from remote resources identified by a URL, URI or IP address.

5. A communication system according to claim 4, wherein the service description document complies with a service description language referring to the SOAP protocol or to the HTTP, HTTPS protocol and providing a grammar based on the eXtensible Markup Language (XML).

6. A communication system according to claim 5, wherein the service description document may contain one or more URL, URI or IP addresses of one or more WEB services.

7. A communication system according to claim 6, wherein the service description document complies with the Service Description Language (SDL).

8. A communication system according to claim 6, wherein the service description document complies with the SOAP Contract Language (SCL).

9. A communication system according to claim 6, wherein the service

description document complies with the Network Accessible Service Specification Language (NASSL).

10. A communication system according to claim 6, wherein the service description document complies with the Web Services Description Language (WSDL).

11. A communication system according to claim 6, wherein several service description documents complying with different service description languages can describe the capacities of a same WEB service.

12. A communication system according to claim 11, wherein the service description document is compressed in a standard compression format for files and documents.

13. A communication system according to claim 11, wherein the service description document of an automation equipment is stored in storage means located in the automation equipment.

14. A communication system according to claim 11, wherein the service description document of an automation equipment is stored in storage means located in a remote device.

15. A communication system according to claim 11, wherein a generator is capable, following a request emanating from a remote device, of constructing a

service description document dynamically, describing the capacities of one or more WEB services implanted in an automation equipment.

16. A communication system according to claim 15, wherein the generator of a service description document of an automation equipment is accessible, for a remote device, via a URL, URI or IP address.

17. A communication system according to claim 16, wherein the generator of a service description document of an automation equipment is stored in storage means located in the automation equipment or in storage means located in a remote device.

18. A communication process on an IP network between an automation equipment running a program to provide automatic control functions and a remote device running a computer program or group of computer programs, the purpose of the communication process being to provide the remote device with supervision, display, control, configuration or programming functions of the automation equipment, the communication process is based on a communications system based on the SOAP protocol and comprising:

running a computer application in the remote device or in another remote device;

sending from the application a read request on the IP network in order to receive, in a response, a service description document,

developing, manually or automatically, by means of the service description document, all or part of a WEB client application and/or a WEB server application in the remote device so as to be able to communicate with a WEB service and/or a WEB

client of the automation equipment respectively,

communicating between a WEB client application and/or a WEB server application of the remote device and a WEB service and/or a WEB client of the automation equipment on the IP network, by means of requests and responses complying with the SOAP protocol.

19. A communication process on an IP network between an automation equipment running a program to provide automatic control functions and a remote device running a computer program or group of computer programs, the purpose of the communication process being to provide the remote device with supervision, display, control, configuration or programming functions of the automation equipment, the communication process based on a communications system based on the SOAP protocol and comprising:

running a computer application in the remote device;

sending from the application a read request on the IP network in order to receive, in a response, a service description document,

communicating between a WEB client application and/or a WEB server application included in the computer application of the remote device and a WEB service and/or a WEB client of the automation equipment on the IP network, by means of requests and responses complying with the SOAP protocol.

20. A communication process according to one of claims 18 or 19, wherein the request contains a URL, URI or IP address which marks either a service description document, or a generator capable of constructing a service description document dynamically.

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IX. EVIDENCE APPENDIX

None.

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X. RELATED PROCEEDINGS APPENDIX

None.